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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,292	09/22/2003	Wei-Han Chang	TOP 331	5626
7590 RABIN & BERDO, P.C. Suite 500 1101 14th Street, N.W. Washington, DC 20005		11/27/2007	EXAMINER MIRZADEGAN, SAEED S	
			ART UNIT 2144	PAPER NUMBER
			MAIL DATE 11/27/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/665,292	CHANG ET AL.
	Examiner	Art Unit
	Saeed S. Mirzadegan	2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 October 2007.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-14 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-14 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 06 July 2007 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This Action is in regards to the Response received on 24 October 2007.

2. Applicant's Amendments, (see Amendments to specifications filed 24 October 2007) with respect to Specifications and Drawings have been fully considered.
Applicant's Amendments are persuasive and sufficient to overcome the following Objections:
 - a. The Objections to Drawings has been withdrawn.
 - b. The Objections to Specifications has been withdrawn except for the following.
 - i. The disclosure is objected to because of the following informalities: as previously indicated in the office action dated 04/26/2007, the term "Pre-storing" should be changed to "restoring". The Abstract to the disclosure still recites this term.
Appropriate correction is required.

3. Applicant's Amendments with respect to claims 4 objections have been fully considered and are not persuasive. Thus the objections to claim 4 have not been withdrawn.

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4. Applicant's Amendments with respect to claim 1 rejection under 35 U.S.C. 112

2nd have been fully considered and are not persuasive. Thus the 35 U.S.C. 112 2nd

objections have not been withdrawn.

5. Applicant's arguments with respect to claims 1-14 have been considered but are

moot in view of the following new ground(s) of rejection necessitated by Applicant's

amendment.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459

(1966), that are applied for establishing a background for determining obviousness

under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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6. **Claims 1-4, 6, 9, 10-12, 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Klein (Klein) US Patent No. 6438687B2, in view of DMI V2.0 Update and further in view of Mattison (Mattison) US. PG. Pub. No. 2002/0069316.

7. Regarding **Claim 1** Klein discloses a method of write-protecting a MAC address of a peripheral device, wherein the MAC address is stored in a first memory (CMOS memory) (**see e.g. col. 2, lines 38-39 (where the MAC address is defined as a BIOS or CMOS memory setting)**), and a backup MAC address is stored in a second memory (DMI Flash Memory) (**see e.g. col. 2, lines 41-44**), the method comprising: executing a DMI setting to write-protect the MAC address stored in the second memory; and providing a program capable of pre-storing an original MAC address for restoring (**see e.g. col. 4, lines 43-54**). However Klein does not explicitly teach DMI memory & disabling programs capable of erasing the MAC address stored in the first memory.

8. In the same field of endeavor, DMI V2.0 Update teaches, (**see e.g. page 2, lines 8-13, DMI memory**).

9. DMI memory, a term not commonly used in the art, is defined as being memory that stores information according to DMI standard.

10. It would have been obvious to one of ordinary skill in the networking art at the time of the applicant's invention to include the DMI memory as disclosed by DMI V2.0

Update in the method disclosed by Klein. It would have been obvious because the DMI memory would allow DMI-enabled management application to access the configuration information disclosed by Klein.

11. In the same field of endeavor Mattison discloses, disabling programs capable of erasing the MAC address stored in the first memory (**see e.g. page 2, ¶0027, lines 6-11) by write protecting the memory, the programs capable of modifying the memory are disabled and are prevented from executing.**

12. It would have been obvious to one of ordinary skill in the networking art at the time of the applicant's invention was made to combine Mattison's teaching as discussed above with the teachings of Klein and DMI V2.0 update for the purpose of (**see Mattison, Page 3, ¶0034, lines 1-3**). Klein provides motivation to do so, by (**see Klein, Page 3, lines 26-28**).

13. Regarding **Claim 10** Klein discloses a method of updating a BIOS setting of a motherboard (**see e.g. Fig. 1, item 10**), the motherboard comprising a first memory (CMOS memory) for storing a media access control (MAC) address of a peripheral device (**see e.g. col. 2 lines 12-15**), and a second memory (DMI Flash Memory) for backing up the MAC address of the peripheral device (**See e.g. Fig. 1, item 40 & col. 4, lines 9-11**), the method comprising: updating the MAC address stored in the first memory using the MAC address in the second memory (**see e.g. col. 4, lines 43-48**),

when a utility program for updating a DMI setting is executed: and updating the BIOS setting of the second memory using the BIOS setting stored in the first memory (**see e.g. col. 4, lines 52-55) system management utility programs.** However Klein does not explicitly teach DMI memory & the MAC address stored in the first memory is set as read-only.

14. In the same field of endeavor, DMI V2.0 Update teaches, (**page 2, lines 8-13, DMI memory).**

15. DMI memory, a term not commonly used in the art, is defined as being memory that stores information according to DMI standard.

16. It would have been obvious to one of ordinary skill in the networking art at the time of the applicant's invention to include the DMI memory as disclosed by DMI V2.0 Update in the method disclosed by Klein. It would have been obvious because the DMI memory would allow DMI-enabled management application to access the configuration information disclosed by Klein.

17. In the Same field of endeavor Mattison discloses, the MAC address stored in the first memory is set as read-only (**Page 5, ¶0065, lines 7-17) the memory is set as read-only since the reprogramming of the memory is not allowed thereby the memory is write protected.**

18. The same motivation utilized in the combination of claim 1, equally applies as well to claim 10.

19. Regarding **Claim 2,11** Klein-DMI update V2.0 and Mattison disclose the invention substantially as claimed. Klein further discloses restoring the MAC address stored in the first memory using the MAC address stored in the second memory when the MAC address stored in the first memory is incorrect (**see e.g. col. 2, lines 44-46**).

20. Regarding **Claim 3,12** Klein-DMI update V2.0 and Mattison disclose the invention substantially as claimed. Klein further discloses restoring the MAC address stored in the second memory using the MAC address stored in the first memory when the MAC address stored in the second memory is incorrect (**col. 2, lines 46-51**).

21. Regarding **Claim 4**, Klein-DMI update V2.0 and Mattison disclose the invention substantially as claimed. Klein further discloses the peripheral device is a local area network (LAN) (**col. 1, lines 27-29**).

22. Regarding **Claim 6**, Klein-DMI update V2.0 and Mattison discloses the invention substantially as claimed. Klein further discloses checking whether an identification code of a MAC address stored in the second memory is correct (**col. 2, lines 22-28**); checking whether the MAC address stored in the first memory is correct if the MAC address stored in the second memory is correct; copying the MAC address stored in the

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second memory to a predetermined register if the MAC address stored in the first memory is incorrect; and disabling the function of setting the MAC address (**col. 2, lines 35-44**).

23. Regarding **Claim 9,14** Klein-DMI update V2.0 and Mattison disclose the invention substantially as claimed. Klein further discloses the second memory is a non-volatile memory (**col. 2, lines 41-42 & col. 4, lines 9-11**).

Claim Rejections - 35 USC § 103

24. **Claims 5,13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Klein-DMI V2.0 Update and Mattison as applied to claims 1 and 10 above, and further in view of Microsoft Computer Dictionary.

25. Regarding **Claim 5,13**, Klein-DMI update V2.0 and Mattison disclose the invention substantially as claimed. However Klein-DMI update V2.0 and Mattison do not explicitly teach the peripheral device is an IEEE1394 device.

26. In the same field of endeavor, Microsoft Computer Dictionary teaches IEEE 1394 (**page 265, col. 1, lines 22-37**).

27. It would have been obvious to one of ordinary skill in the networking art at the time of the applicant's invention to include the IEEE1394 device as disclosed by

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Microsoft Computer Dictionary in the method disclosed by Klein-DMI update V2.0 and Mattison. It would have been obvious because the inclusion of IEEE 1394 devices would expand the type of I/O devices that are serviced by the method disclosed by Klein.

Claim Rejections - 35 USC § 103

28. **Claims 7,8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Klein-DMI V2.0 Update and Mattison as applied to claim 1 above, in further view of Shinjo et al. (Shinjo) US Patent No. 5269022.

29. Regarding **Claim 7**, Klein-DMI update V2.0 and Mattison disclose the invention substantially as claimed. However Klein-DMI update V2.0 and Mattison do not explicitly teach setting an updated flag of the MAC address of the second memory if the identification code of the MAC address of the second memory has been updated.

30. In the same field of endeavor, Shinjo teaches setting the updated flag of the MAC address of the second memory if the identification code of the MAC address of the second memory has been updated (**Fig. 2 & col. 1, lines 38-48 & lines 53-64**).

31. It would have been obvious to one of ordinary skill in the networking art at the time of the applicant's invention was made to combine setting the update flags as disclosed by Shinjo in the method disclosed by Klein-DMI V2.0 update and Mattison. It

would have been obvious because the setting of the update flags would eliminate the possibility of unnecessary replacement of the content of the memory a second time.

32. Regarding **Claim 8**, Klein-DMI update V2.0 and Mattison disclose the invention substantially as claimed. Klein further discloses if the identification code (checksum) of the MAC address in the second memory has not been updated; determining whether the identification code stored in the first memory is correct; copying the MAC address in the first memory to the second memory if the identification code in the first memory is correct; and setting the updated flag of the MAC address in the second memory (**FIG. 2A & 2B**). However Klein-DMI update V2.0 and Mattison do not explicitly teach setting the updated flag of the MAC address of the second memory.

33. In the same field of endeavor, Shinjo teaches setting the updated flag of the MAC address of the first memory if the identification code of the MAC address of the first memory has been updated (**Fig. 2 & col. 1, lines 38-48 & lines 53-64**).

34. It would have been obvious to one of ordinary skill in the networking art at the time of the applicant's invention was made to combine setting the update flags as disclosed by Shinjo in the method disclosed by Klein-DMI V2.0 update and Mattison. It would have been obvious because the setting of the update flags would eliminate the possibility of unnecessary replacement of the content of the memory a second time.

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Prior Art of Record

35. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please refer to form PTO-892 (Notice of Reference Cited) for a list of relevant prior art.

Conclusion

36. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Saeed S. Mirzadegan whose telephone number is 571-270-3044. The examiner can normally be reached on M-F 8:00-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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